

REMARKS

I. STATUS OF CLAIMS

Claims 1-28 are pending in the application. Of these claims, claims 13-20 and have been withdrawn from consideration. Claims 2, 3 and 25 have been canceled without prejudice or disclaimer of the subject matter therein. Claims 1, 4-12, 21-24, and 26-28 are pending in the present Application. In the above amendments, Claims 1, 6, 24 and 26 have been amended.

Claim 25 was rejected in the Office Action under 35 U.S.C. § 112, first paragraph ("Section 112, Par. 1") as allegedly failing to comply with the written description requirement.

Claims 1, 4, 5, 7, 9, 11, 21, 24, 27, and 28 were rejected in the Office Action under 35 U.S.C. § 103(a) ("Section 103(a)") as being unpatentable over Otake (JP2000-201545) (hereinafter referred to as "Otake") in view of Bales (US 4,258,503) (hereinafter referred to as "Bales").

Claims 6, 8, and 10 were rejected in the Office Action under Section 103(a) as being unpatentable over Otake in view of Bales in further view of DiMuzio (US 6,237,882 B1) (hereinafter referred to as "DiMuzio").

Claim 12 is rejected in the Office Action under Section 103(a) as being unpatentable over Otake in view of Bales in further view of Pierce (US 4,190,984) (hereinafter referred to as "Pierce").

Claims 22 and 23 were rejected in the Office Action under Section 103(a) as being unpatentable over Otake in view of Bales in further view of Pan (US 5,850,927) (hereinafter referred to as "Pan").

Claims 26 is rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales in further view of Otake (JP2001-62156).

Applicant respectfully traverses all rejections and requests reconsideration.

A. REJECTION UNDER SECTION 112, PAR. 1

Claim 25 has been rejected under Section 112, Par. 1. Although claim 26 was identified in the Office Action, it is understood claim 25 was meant to be rejected. Applicant has canceled claim 25 without prejudice or disclaimer of the subject matter therein. Accordingly, Application respectfully requests withdrawal of the rejection under Section 112, Par. 1.

B. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES

Claims 1, 4, 5, 7, 9, 11, 21, 24, 27, and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales.

Independent claims 1 and 24 have been amended and Applicant submits the novel physical features of the claims are unobvious and hence patentable over Otake and Bales for the following reasons:

The Novel Subject Matter of Claims 1 and 24 Is Unobvious Over Otake and Bales Under §103

Claim 1 and 24 have been amended to recite the limitation that the “two or more separable members further comprise support pieces to support the frame and a *smooth edged woven mesh filler woven over and about the support pieces* filling a number of spaces between the support pieces.” (emphasis added). This incorporates the limitations disclosed in claims 2 and 3 and further adds the limitation of having a smooth edged woven mesh structure. Support for such amendment is found in the Applicant’s specification (See Application paragraphs 0010, 0011, 0013, 0025 and 0031). Such smooth edged woven mesh filler is not provided by the references of either Otake or Bales.

Neither are such limitations provided by DiMuzio. Examiner rejected claims 2 and 3 under Section 103(a) as being unpatentable over Otake in view of Bales in further view of DiMuzio because DiMuzio discloses a filler frame of mesh along a number of gaps between support pieces; however, DiMuzio does not disclose the limitation of “smooth edged woven mesh filler woven over and about the support pieces”. Topiary frames in the past have been constructed by means of pressing a prefabricated mesh over a mold and

cutting wires to conform to a specific shape. Such is the case in DiMuzio, where there is no smooth edged **woven mesh over and about support pieces**, but rather a prefabricated wire mesh (chicken wire) wrapped around. In DiMuzio and other frames, such chicken wire is normally cut to fit the shape of a structure. DiMuzio clearly fails to teach the smooth edged woven structure of filler over and about the support pieces, as in Applicant's claims and only discloses placing chicken wire or similar material around the structure. The cutting of the chicken wire necessary in such a frame leads to a number of cut sharp wires, which are a danger to the manufacturers and the owners of the frames. This is precisely the problem of such a topiary frame the present invention intends to overcome. (See Application, pars. 0003 and 0011). In the present invention, the woven mesh is structured as a smooth edged woven filler woven about the support pieces; and thus minimizes the number of sharp edges or protruding wire ends which could injure a person or plant.

Moreover, a new and unexpected result of the present invention is that it can be more easily and more uniformly produced than expected for a product incorporating both support pieces and a smooth edged woven mesh woven about the support pieces. As mentioned, topiary frames in the past include basic frames with only support pieces or simply pressed mesh frames. The present invention however, combines both support pieces and a novel woven smooth edged mesh structure. In addition, the woven structure also allows for differing sizes of the woven structure throughout the frame of the invention such that parts of the members can have a woven structure of more density than other parts of the members. The woven structure also facilitates filling the spaces along the movable parts of the frame and also for smaller areas of the frame where prefabricated mesh cannot be used due to its standard layout. Such flexibility is not provided and impractical in the traditional topiary frame using a press molded filler. The frame of the present invention eliminates the need for trimming of extraneous mesh from a frame as in traditional frames, such as DiMuzio, and thus reduces overall costs in producing such a frame.

The Present Topiary Frame Is Commercially Successful, Militating in Favor of Patentability

The courts have held and the MPEP states (§ 2141) that commercial success of a product covered by the claims of a patent application is relevant to the issue of obviousness. Applicant submits evidence of commercial success to strengthen his argument in view of the novel features in the present claims and the fact that such features produce new and unexpected results as discussed above.

Attached as *Exhibit A*, is a declaration from Applicant attesting to such commercial success and the nexus between such success and the novelty of the claimed subject matter.

Dependent Claims of Claims 1 and 24 are A Fortiori Patentable Over Otake and Bales

Dependent claims 4, 5, 7, 9, 11, 21, 27, and 28 include all limitations of their respective base claims, claims 1 and 24 and recited additional novel features over Otake and Bales. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as is amended claims 1 and 24.

C. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES IN FURTHER VIEW OF DIMUZIO

Claims 6, 8, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales in further view of DiMuzio. Claim 6 was amended to reflect its dependence on claim 1 instead of withdrawn claim 3.

Dependent claims 6, 8, and 10 are all ultimately dependent upon the limitations of amended claim 1. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as is amended claim 1. Furthermore, Applicant respectfully submits that these dependent claims are further allowable for the limitations that they themselves recite.

For example, dependent claim 8 recites that “the upper and lower extremity set of members correspond to objects in addition to arms or legs; the main structure corresponding to a middle region of the animal form.” In rejecting claim 8, the Examiner

cites to element 20 from Figure 14 of DiMuzio. (See Fig. 14 and col. 4 lines 11-21). Element 20 of DiMuzio is described as “corkscrew shaped pins.” (See col. 4 lines 6-7). An actual fruit, vegetable, or candles can be mounted to the threaded corkscrew. (See col. 4 lines 11-21). However, claim 8, which depends from the limitations of claim 7, states that the “objects” corresponding to the “upper and lower extremity set of members” are “for enclosing topiary foliage” and having a “three-dimensional unitary form.” Thus, while DiMuzio describes having actual fruits attached to the topiary, these fruits are not part of any “three-dimensional unitary form” of the “topiary frame”; in fact, the cited element 20 is a pin, which is in no manner “for enclosing topiary foliage.” As such, DiMuzio does not disclose a topiary frame comprising objects “for enclosing topiary foliage” but rather teaches that actual fruits, which are not part of the frame, are attached independently to “pins” on the frame.

In rejecting claim 10, the Examiner stated that the limitations of claim 8 are disclosed by DiMuzio and that a

“bear design with fruit etc. was an art-recognized equivalent to a seal and ball in animal-from topiaries where in is immaterial as the exact animal form, it would have been obvious to one of ordinary skill in the art at the time the invention to substitute the bear/fruit with the seal/ball in the topiary of Otake as modified by DiMuzio.”(Office Action, page 5-6).

However, Applicant disagrees with the Examiner’s assertion, because nowhere is there any suggestion of a bear with fruit, especially because as discussed above, the fruit of DiMuzio is actual fruit mounted to “protrusions”, “threaded corkscrews”, and in no manner a part of the three-dimensional unitary form of the topiary frame for “enclosing topiary foliage” as required in claim 10. Furthermore, neither does DiMuzio provide for all the claim limitations of claim 10, as it is ultimately dependent upon the limitations of amended claim 1, which are deficient in Otake as discussed above. Accordingly, Otake in view of DiMuzio fail to teach or suggest ALL claim limitations as required to establish a prima facie case of obviousness.

In light of these reasons and the reasons for amended claim 1, Applicant respectfully submits that claims 6, 8, and 10 are allowable and requests withdrawal of the rejections.

**D. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES IN
FURTHER VIEW OF PIERCE**

Claim 12 is rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales in further view of Pierce.

Dependent claim 12 is dependent upon the limitations of amended claim 1 and Pierce does not resolve the deficiencies discussed above in connection with amended claim 1. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as is amended claim 1.

**E. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES IN
FURTHER VIEW OF PAN**

Claims 22 and 23 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales in further view of Pan.

Dependent claims 22 and 23 are all ultimately dependent upon the limitations of amended claim 1 and Pan does not resolve the deficiencies discussed above in connection with amended claim 1. Accordingly, Applicant respectfully submits that claims 22 and 23 are allowable for at least the same reasons as is amended claim 1 and requests withdrawal of the rejection of claims 22 and 23 under Section 103(a).

**F. REJECTION UNDER SECTION 103(a), OTAKE IN VIEW OF BALES IN
FURTHER VIEW OF OTAKE**

Claims 26 is rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Bales in further view of Otake (JP2001-62156).

Dependent claim 26 is dependent upon the limitations of amended claim 1 and Otake (JP2001-62156) does not resolve the deficiencies discussed above in connection with amended claim 1. Furthermore, claim 26 has been amended with additional claim limitations wherein "the smooth edged woven mesh filler is woven more densely in some portions of the members than in other portions of the members". As such, since none of the references provide for such a structure of the frame having a differing woven density in the smooth edged woven mesh filler, not all the limitations of claim 26 have been taught.

Accordingly, Applicant respectfully submits that dependent claim 26 is allowable for at least the same reasons as is amended claim 1 and for the additional limitations it recites. In light of this and the reasons for amended claim 1, Applicant respectfully submits that claim 26 is allowable and requests withdrawal of the rejection under Section 103(a).

II. CONDITIONAL REQUEST FOR CONSTRUCTIVE ASSISTANCE

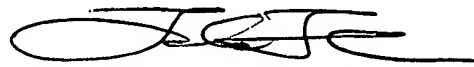
Applicant has made a diligent effort to amend the claims of this application so that they define novel and unobvious structure. If, for any reason, the Examiner believes that the claims of this application are not yet in full condition for allowance, applicant respectfully requests his constructive assistance and suggestions pursuant to the spirit of MPEP § 2173.02 and § 707.07(j). This will enable the undersigned to place this application in fully allowable condition as soon as possible and without the need for further proceedings. The Examiner is authorized to make any needed minor corrections or changes.

III. CONCLUSION

The above-discussed amendments and remarks are believed to place the present Application in condition for allowance. Should the Examiner have any questions regarding the above amendments, the Examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

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